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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,409	03/24/2004	Tze Wan Pansy Chung	44904.000606	3858

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EXAMINER
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WATKINS III, WILLIAM P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/807,409

Applicant(s)

CHUNG ET AL.

Examiner

William P. Watkins III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

The address of Tze Wan Pansy Chung was changed and not initialed by all inventors. A new oath is required. The examiner notes that one is being prepared.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (U.S. 2003/0003269 A1) in view of Chappell et al. (U.S. 5,518,801).

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Lee et al. teaches a cell apertured film with large elongated cells in rows and smaller apertures arranged in a pinwheel configuration around the larger apertures. The film may be made elastic and retractable by being processed as a structural elastic film (abstract, Figure 1, claim 13).

Chappell et al. teaches an embossing process to produce elastic type extension and retraction ability in a film (abstract). The instant invention claims a film with oval formed apertures in a film that has extension and retraction abilities. It would have been obvious to one of ordinary skill in the art to have formed the apertured film of Lee et al. using a structured elastic film process in order to form an elastic topsheet because of the teachings of Chappell et al.

4. Claims 1-13, 18-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mormon et al. (U.S. 6,472,045) in view of Desai et al. (U.S. 2003/0021951).

Mormon et al. teaches an apertured elastic film necked web laminate that extends and contracts (abstract). Desai et al. teaches using an elongated apertured web to allow extension and the preservation of open space in the web when stretched in the cross direction to the axis of the apertures (abstract). It

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would have been obvious to one of ordinary skill in the art to have used the apertured web structure in the non elastic webs and films of Mormon et al. in order to better preserve the open area of the laminate when it is stretched.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being

unpatentable over claims 1-20 of copending Application No. 10/882,871. Although the conflicting claims are not identical, they are not patentably distinct from each other because stress lane depression wall language of the sister application is based on the same structures as the instant claims and therefore render the instant claims obvious to one of ordinary skill in the art. The applications having the same effective filing date only a one way showing is needed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Applicant's arguments filed 13 March 2006 have been fully considered but they are not persuasive.

Applicant argues for both the rejection of Lee et al. in view of Chappell et al. and the rejection of Mormon in view of Desai et al. that no aligned plurality of cells designed to produce elasticity are taught and that no retractive mechanism is taught. The examiner disagrees. The examiner notes that page 5 of the specification at section 0025 simply defines "elastic" as a material which stretches or elongates when exposed to a biasing force. Both Lee et al. and Desai et al.

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have elongated apertures that are aligned in columns in plastic film materials. When a force is applied in a normal direction to these columns, the elongated cells will stretch and become wider in the direction of the minor axis of the cells. This will allow the entire sheet to become wider in the direction normal to the columns. This both meets the definition of "elastic" in the instant specification and is the specific elongation mechanism disclosed in the specification (see Figure 1 of the instant specification).

Regarding lack of a retraction mechanism, Lee et al. is taught in claim 13 and section 0096 as being formable as a SELF-ing material. In section 0096 of Lee et al., the secondary Chappell et al. reference is incorporated by reference. Col. 2, liens 15-35 of Chappell et al. clearly state that the film acts like a traditional elastic material with stretching under force and return or retraction of the material to the original size when the force is released. This meets the retractive force mechanism limitation of the instant claims. The necked laminates of Morman et al. also allow extension and retraction. This ability to retract meets the retractive force mechanism limitation of the instant claims. Making the apertures of Morman et al. in the elongated shape of Desai et al. further

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enhances the ability of the material to elongate in a direction normal to the elongated aperture columns taught by Desai et al. Thus the limitations of the independent claims are taught and there is motivation to combine the references.

Regarding the pinwheel teaching of Lee et al., circles of various diameters can be drawn around any of the elongated apertures of Lee et al. Any such circle of a given diameter will intersect a group of the smaller openings that are arrayed in a circle about the elongated aperture. This is a pinwheel type of structure as described in the instant specification. The examiner notes that there was no response given to the obviousness type double patenting rejection in 7 of the detailed portion of the first office action. This has been repeated above.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened



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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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WW/ww

May 30, 2006

*William P. Watkins III*

**WILLIAM P. WATKINS III  
PRIMARY EXAMINER**